

Remarks

I. Support for Amendments

Of the 21 original or previously added claims, claim 9 has been canceled without disclaimer or prejudice to the underlying subject matter, and claim 17 has been amended. Support for the foregoing claim amendment may be found throughout the specification and in the original claims, for example, at page 18, line 32 through page 21, line 19. Upon entry of the foregoing amendment, this application presently contains claims 1-2, 10-21, and 31-36. No new matter enters by this amendment. Applicant respectfully submits that this amendment puts the application in condition for immediate allowance or appeal.

II. Applicant's IDS

Applicant appreciates that the Examiner has returned the initialed copy of page one of Form PTO-1449 that was filed on November 20, 2001. Applicant notes, however, that the Form PTO-1449 filed on November 20, 2001 consisted of three pages, but that Applicant has received the initialed copy of only page one of three. Applicant therefore respectfully requests that the Examiner return the initialed copies of the second and third pages of the Form PTO-1449 filed on November 20, 2001.

III. Withdrawal of Prior Rejections

Applicant thanks the Examiner for finding claims 1, 2, 9-21 and 31-36 to be free of the prior art. Applicant further thanks the Examiner for allowing claims 1, 2, 10-16 and 18-21. Office Action at page 4.

IV. Objections to Claims 31-36

Claims 31-37 were objected to as being dependent upon a rejected base claim. Office Action at page 4. Applicant thanks the Examiner for indicating that claims 31-37 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Office Action at page 4. Applicant respectfully brings to the Office's attention that there is no pending claim 37 in this application; accordingly, Applicant will treat this objection as if it had been applied to claims 31-36.

Applicant has followed the Examiner's suggestion in amending claim 17 to recite "or any **transgenic** part thereof." See Office Action at page 4. Applicant respectfully submits that, after this amendment of claim 17, claims 31-36 will no longer be dependent on a rejected base claim. Applicant therefore submits that the grounds for the objections to claims 31-36 has been rendered moot. In light of these remarks, applicant respectfully requests withdrawal of these objections.

V. Rejection of Claim 9 under 35 U.S.C. § 112, First Paragraph (Enablement)

Claim 9 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Office Action at page 3. Specifically, the Office alleges that "[n]o guidance has been provided for the use of any of a multitude of broadly claimed polynucleotides of Claim 9, wherein only a small fragment of the polynucleotide comprises SEQ ID NO: 1." Office Action at page 3. Applicant disagrees.

Applicant submits that the Office has failed to meet its burden for demonstrating that Applicant has not enabled the alleged “multitude of broadly claimed polynucleotides” of claim 9. However, in order to facilitate prosecution, Applicant has cancelled claim 9 without prejudice to or disclaimer of the subject matter contained therein.

VI. Rejection of Claim 17 under 35 U.S.C. § 101

Claim 17 stands rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Office Action at page 4. Specifically, the Office alleges that claim 17 encompasses “untransformed plants and seeds, which are a product of nature and not one of the five classes of patentable subject matter.” Office Action at page 4. Applicant thanks the Examiner for suggesting that amendment of claim 17 to recite “or any **transgenic** part thereof” would obviate this rejection. Office Action at page 4. Applicant has amended claim 17 according to the Examiner’s suggestion. Applicant respectfully submits that the grounds for the rejection of claim 17 under 35 U.S.C. § 101 have been rendered moot. In light of these remarks, applicant respectfully requests withdrawal of this rejection under 35 U.S.C. § 101.

Conclusion

In view of the foregoing arguments and amendments, each of the presently pending claims is believed to be in immediate condition for allowance. All of the stated grounds of rejection have been traversed, accommodated, or rendered moot. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and pass this application to issue. The Examiner is encouraged to contact the undersigned at 202.942.5234 should any additional information be necessary for allowance.

Respectfully submitted,

A handwritten signature in black ink that reads "Rachel L. Adams". The signature is written in a cursive, flowing style.

Rachel L. Adams (Reg. No. 54,660)
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